UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/644,955	08/21/2003	Kazuo Okada	3022-0020	6676

20457 7590 10/03/2006

ANTONELLI, TERRY, STOUT & KRAUS, LLP
1300 NORTH SEVENTEENTH STREET
SUITE 1800
ARLINGTON, VA 22209-3873

EXAMINER	
SHAH, MILAP	

ART UNIT	PAPER NUMBER
3712	

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/644,955	OKADA, KAZUO	
	Examiner	Art Unit	
	Milap Shah	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 August 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 August 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *11/18/03, 2/24/05, & 2/25/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Specification

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over amended or new claims 13-16 of copending Application No. 10/697,256. Although the conflicting claims are not identical, they recite similar subject matter. The conflicting claims referenced here are recently amended or added claims in that co-pending case of which the associated amendment was filed on August 29, 2006.

In co-pending Application No. 10/697,256, it can be seen fairly obvious to have reworded each of the limitations, such that each "device" is now a "means" in the instant application. It is obvious to modify the wording to produce either one of these claimed inventions, given the other, as each appears to include the same structural components of a gaming machine. One would have been motivated to make the modification for the purpose of including functional language within the claim of the instant application. It appears "means for" is used to invoke 112, 6th paragraph. Thus, the claimed invention of claims 1-4 of the instant application and the claimed invention of claims 13-16 of co-pending application no. 10/697,256 are considered obvious variants at the least.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent

by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated Nishikawa (JP Publication No. 2000-300729). The English translation of abstract, detailed description, and claims is provided with this Office Action (Nishikawa was cited by the Applicant).

Claim 1: Nishikawa discloses the same gaming machine comprising a variable display means for varying displaying a plurality of symbols (i.e. gaming reels or drums), lottery means for executing a lottery for a prize pattern (i.e. random outcome), a stop control means for controlling and stopping the variable display means (i.e. a motor for stopping the reels), and a stop control selection means for selecting a control type of the stop control means based on a result of the lottery (i.e. setting the reels to stop at the correct positions corresponding to the random outcome) (see at least abstract, figures 3-5, and paragraphs 0002-009, 0013-0021 of English translation). Nishikawa also discloses shielding means and shielding control means for shielding a view of the variable display means, the shielding means being disposed in front of the variable display means (i.e. disable a player from viewing non-winning symbols via the liquid crystal display becoming opaque or colored in those positions, and enable a player to view the symbols associated with the winning pay line or winning combination so as to highlight the winning combination) *See at least abstract, figures 3-5, and paragraphs 0002-0021 of English translation.*

Claim 2: The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Claims 3 & 4: Nishikawa discloses the structure of the liquid crystal display capable as the shielding means for shielding the contents of the variable display, which is capable shielding via an effect display or bonus game. Thus, the shielding control means would control the shielding means to overlay the bonus game. The liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa.

Claims 5-8, & 10: Nishikawa discloses the invention substantially as claimed including a gaming machine having a display device (i.e. the entire front of the gaming display is a 'display device'), in which the display device comprises a substantially transparent panel disposed on the display device (i.e. the panel on the front of the machine that provides transparent openings for a player to view the reels), an image display device (i.e. an LCD) for displaying an image, the image display device being provided behind the panel so as to show the image visibly through the panel (i.e. an LCD layer which projects images to show the images visibly to through the transparent openings), and a variable display device for

displaying symbols behind the transparent layers (i.e. game machine reels with a plurality of symbols on an outer peripheral surface).

Nishikawa explicitly lacks a separate transparent EL layer to act as an electronic shutter such that the shutter shields the variable display whenever the gaming machine requires the symbols to be shielded, based upon control of the gaming machine by a player (i.e. submitting a wager to start the game). Regardless of the deficiency, it would have been well known in the art to one of ordinary skill to merely duplicate the image display device layer, since the electronic shutter layer merely acts as a transparent panel (substantially flat), which either is clear (substantially transparent) or dark, such that an image display device is capable of being duplicated and used for this purpose. The Examiner submits the shutter layer and image display layer are considered equivalent layers and are capable of performing the desired tasks with equivalent structure. It has been held that mere duplication of essential working parts of a device involves only routine skill in the art. See *St. Regis Paper Co. v Bemis Co, 193 USPQ 8.* Therefore, it would have been obvious to one of ordinary skill in the art to modify Nishikawa with an additional transparent EL layer (i.e. an LCD) as discussed above in order to separate the tasks of shielding and displaying images pertaining to the game itself. *See at least abstract, figures 3-5, and paragraphs 0002-0021 of English translation.*

Claim 9: Nishikawa discloses a lamp or light behind the display such symbols can be highlighted via illumination (paragraph 004)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Name	Reference	Applicability
Lally et al.	U.S. Patent No. 3,642,287	Rotaing reel game with masking shutter.
Motegi et al.	U.S. Patent No. 6,817,946	Virtual image and reel images superimposed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.

Scott E. Jones

SCOTT JONES
PRIMARY EXAMINER